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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,680	07/24/2003	Todd Anthony Layt	9341.22	1385
20792	7590	03/10/2004	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC PO BOX 37428 RALEIGH, NC 27627				HWU, JUNE
ART UNIT		PAPER NUMBER		
		1661		

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/626,680	LAYT, TODD ANTHONY
Examiner	Art Unit	
June Hwu	1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 July 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \*    c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/6/04.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: Rule 105 requirement.

#### **DETAILED ACTION**

The declaration filed December 23, 2003 has been received. The information disclosure statement filed January 6, 2004 has been received.

#### **35 USC § 102**

The cultivar LM400 is described the Plant Breeder's Right application number 2001090 filed in Australia on April 3, 2001, more than one year prior to filing of this instant application. The Secretary as soon as reasonably possible after an application for Plant Breeder's Right is filed will decide whether to accept or reject an application. Once the application is accepted, the Secretary will give public notice of the accepted application and anybody is entitled to a copy of the application for PBR in a plant variety, of an objection to such an application, or of a detailed description of the plant variety. Thus information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re Le Grice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether 'Siokra' seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the cultivar Siokra disclosed in the cited publications.").

While the publication cited above discloses the claimed plant variety, a question remains as to whether the reference is enabling. If the plant was publicly available, then the application

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combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of electronic databases, the Internet and the Office's collection of retail catalogs have not revealed any evidence that the claimed plant was on sale anywhere in the world. However, the Office's collection of retail catalogs is not comprehensive. Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties free of charge. Since the inventor and assignee of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information in the attached Requirement for Information Under 37 CFR 1.105.

This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

In order to consider whether a 102(b) rejection should be applied, the Examiner is requesting information pertaining to the claimed cultivar.

#### **Objection to the Disclosure**

#### **37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

**35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant application filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) because the specification presents less than a full and complete botanical description and the characteristics which distinguish over related known varieties.

More specifically:

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A. Applicant is requested to change the cultivar name 'LM400' because it does not comply with the International Code of Nomenclature for Cultivated Plants - 1980. Article 4 states the importance of cultivar name registration for nomenclature stability; Article 31, Recommendation 31A(a) states that "Names composed of abbreviations, numerals or arbitrary sequences of letters except as established custom in a country or for a crop requires" should be avoided.

B. Applicant should set forth in the specification whether the claimed plant is dioecious or monoecious.

C. Applicant must provide more meaningful color descriptions for the instant variety with reference to a recognized color chart, such as the RHS Colour Chart. Applicant should supplement the general color descriptions currently set forth with color designations from the employed color chart, for such botanical features as leaf blade (upper and lower surface), opened flower and etc. See MPEP § 1605.

D. Applicant should import into the specification the plant hardiness zone or the heat/cold resistance for the claimed plant.

E. Applicant should set forth in the specification the average height and spread of the claimed plant.

F. Applicant should set forth in the specification a brief description of the roots.

G. Applicant should set forth in the specification if the claimed plant is stoloniferous or not.

H. Applicant should set forth in the specification the venation pattern and the color designation with reference from an employed color chart, if different from the rest of the leaf blade.

I. Page 3, line 32, the color description of the leaf as "blue/grey" is vague and does not sufficiently describe the color designation with reference from an employed color chart. Correction is necessary.

J. Applicant should set forth in the specification a botanical description of the leaf base, leaf margin and leaf surface texture.

K. Applicant should set forth in the specification a botanical description of any auricles.

L. Page 3, line 34, the recitation "white/green and light brown" does not sufficiently describe the color designation of the basal shoot with reference to an employed color chart. Correction is necessary.

M. Applicant should set forth in the specification a botanical description of the leaf sheath length, type (open, split, overlapping margins or closed with margins fused) and color designation with reference to an employed color chart.

N. Applicant should set forth in the specification whether the emerging new leaves from the whorl of preceding leaves are folded or rolled.

O. Applicant should set forth in the specification the botanical description of the culm (stem) such as color designation, size, and surface texture.

P. Applicant should set forth in the specification whether the internodes are hollow, pithy or solid.

Q. Applicant should set forth in the specification the botanical description of the ligule's type and shape.

R. Page 4, line 2, the recitation "(flower spike) is yellow" is vague and does not sufficiently describes the color designation with reference from an employed color chart. Correction is necessary.

S. Applicant should set forth in the specification the inflorescence type.

T. Applicant should set forth in the specification a botanical description of the spikelet, such as, glumes (size and color designation), lemma (size and color designation), awn (length), and palea (size and color designation).

U. Applicant should set forth in the specification the average length of the flower rachis.

V. Applicant should set forth in the specification the flowering culm's average length and color designation with reference to an employed color chart.

W. Applicant should set forth in the specification the pedicels' length and color designation with reference to an employed color chart.

X. Applicant should set forth in the specification the fragrance of the flower and/or leaves, if any.

Y. Applicant should set forth in the specification the flowering period at a given location of culture.

Z. If available, the applicant should set forth into the specification the lastingness of the bloom.

AA. Applicant should set forth in the specification a botanical description of the seed's size, shape, and color designation with reference to an employed color chart.

AB. Applicant should set forth in the specification the botanical description of the reproductive organs such as number, size and color designation of the anther, filament, ovary, stigma, style and caryopsis, if available.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class.

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Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

### **Claim Rejection**

#### **35 USC § 112, 1st and 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

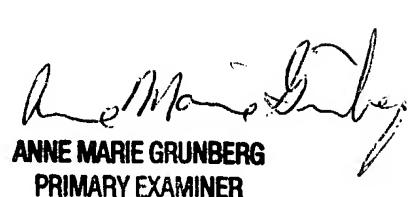
### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

JH



ANNE MARIE GRUNBERG  
PRIMARY EXAMINER

### **REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105**

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine when, if ever, the claimed plant variety, 'LM400', was publicly available prior to the filing date of the instant application.

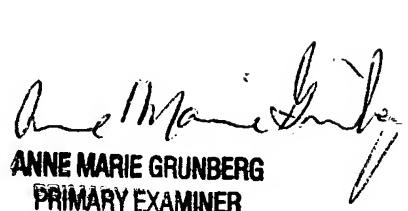
In response to this requirement please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution. Also, please provide a copy of the application cited in the attached Office Action. The Office does not maintain a collection of Breeders' Rights documents and they are not readily obtainable electronically. Since the assignee of the instant application is listed by UPOV as applicant, breeder and titleholder of the granted Breeder's Right, it is reasonable to expect that Applicant or the assignee can readily obtain the requested documents and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the

scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.



ANNE MARIE GRUNBERG  
PRIMARY EXAMINER